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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,292	06/15/2001	Laura T. Putnam	2709/113	6870

2101 7590 08/27/2009

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EXAMINER	
BOYCE, ANDRE D	
ART UNIT	PAPER NUMBER
3623	

MAIL DATE	DELIVERY MODE
08/27/2009	PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte LAURA T. PUTNAM,
EILEEN C. SHAPIRO,
and
STEVEN J. MINTZ

Appeal 2009-001096
Application 09/882,292
Technology Center 3600

Decided: August 27, 2009

Before MURRIEL E. CRAWFORD, JOSEPH A. FISCHETTI, and BIBHU R. MOHANTY, *Administrative Patent Judges.*

CRAWFORD, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a final rejection of claims 3-62, 80-102, and 104-124. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented systems and methods for analyzing job functions across different industries, particularly for identifying employment options for individuals and for identifying appropriately qualified job candidate populations for employers (Spec. 1:12-15).

Claim 3 under appeal is further illustrative of the claimed invention as follows:

> 3. A computerized method of identifying industries for potential transfer of a job function capability with respect to a first industry, the method comprising:
>
> a. in a first digital computer process, identifying a job function in the first industry;
>
> b. in a second digital computer process, accessing a database, stored on a digital storage medium, that correlates, for the job function, the first industry with a set of second industries with respect to which the job function capability is potentially transferable; and
>
> c. in a third digital computer process, using the database to identify the second industries.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Salmon	US 5,592,375	Jan. 7, 1997
Joao	US 6,662,194 B1	Dec. 9, 2003

The Examiner rejected claims 3-6, 8-12, 14, 15, 17, 19, 21, 23, 24, 28-30, 34-38, 40, 42, 43, 45, 47, 49, 51, 53-55, 59, 61, 80-102, 104, 105, 111, 112, 118, and 119 under 35 U.S.C. § 102(b) as being anticipated by Salmon; rejected claims 7, 13, 16, 18, 20, 22, 25-27, 31-33, 39, 41, 44, 46, 48, 50, 52, 56-58, 60, and 62 under 35 U.S.C. § 103(a) as being unpatentable over Salmon in view of Joao; and rejected claims 106-110, 113-117, and 120-124 under 35 U.S.C. § 103(a) as being unpatentable over Salmon.

We AFFIRM-IN-PART.

ISSUES

Did the Appellants show the Examiner erred in finding that Salmon does not disclose accessing a database that correlates, for a job function, a first industry with a set of second industries with respect to which the job function capability is potentially transferable, as recited in independent claims 3, 80, and 88?

Did the Appellants show the Examiner erred in rejecting dependent claims 7, 13, 16, 18, 20, 22, 25-27, 31-33, 39, 41, 44, 46, 48, 50, 52, 56-58, 60, and 62, because Joao is not cited as remedying the deficiencies of the independent claims from which they ultimately depend?

Did the Appellants show the Examiner erred in rejecting dependent claims 106-110, 113-117, and 120-124, because the additional assertions set forth by the Examiner are not cited as remedying the deficiencies of the independent claims from which they ultimately depend?

FINDINGS OF FACT

Specification

Appellants invented systems and methods for analyzing job functions across different industries, particularly for identifying employment options for individuals and for identifying appropriately qualified job candidate populations for employers (Spec. 1:12-15).

Salmon

Salmon discloses that the industry, function, and skill set for each resume item of a candidate is logically correlated in a database, and the data for each resume item is kept logically separate from the data for the candidate's other resume items (col. 4, ll. 53-57).

A candidate with "'Production experience in the Biotechnology industry'" and "'Design experience in the Aerospace industry'" should not match a search for "'Design experience in Biotechnology'" (col. 4, ll. 50-53).

A Buyer's Profile may specify that industry and experience must match exactly, or the Buyer's Profile may merely give weights to the industry or experience (col. 5, ll. 38-46; col. 9, ll. 40-56).

PRINCIPLES OF LAW

Anticipation

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Obviousness

One of ordinary skill in the art would have found it obvious to update the prior art device by using modern electronic components in order to gain the commonly understood benefits of such adaptation, such as decreased size, increased reliability, simplified operation, and reduced cost. The combination is thus the adaptation of an old idea or invention using newer technology that is commonly available and understood in the art. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007).

ANALYSIS

Correlating First and Second Industries

We are persuaded of error on the part of the Examiner by Appellants' argument that Salmon does not disclose accessing a database that correlates, for a job function, a first industry with a set of second industries with respect to which the job function capability is potentially transferable, as recited in independent claims 3, 80, and 88 (App. Br. 11-13, Reply Br. 2-4). Salmon discloses logically correlating industry, function, and skill set for each *resume item* of a candidate, e.g., classifying a candidate, based on their resume, as having experience in a particular industry. Salmon also discloses a *user* creating a Buyer Profile that weights industry and experience to create matches. However, independent claims 3, 80, and 88 recite accessing a *database* that correlates a first industry with a set of second industries. In Salmon, the database merely *stores* a candidate's assigned industry, and does not *correlate* that candidate with another industry. While the user creating a Buyer Profile may correlate a candidate with multiple industries, independent claims 3, 80, and 88 recite that it is the database, and not the

user, that performs the correlation. As this is a rejection under § 102(b), and Salmon does not disclose the aforementioned aspects of independent claims 3, 80, and 88, we are constrained to reverse this rejection. *See Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d at 631.

Joao

The Appellants are correct in regard to the disclosure of Joao as it relates to the rejection of dependent claims 7, 13, 16, 18, 20, 22, 25-27, 31-33, 39, 41, 44, 46, 48, 50, 52, 56-58, 60, and 62 (App. Br. 14). However, Salmon discloses that the user creating a Buyer Profile correlates a candidate with multiple industries by weighting industry and experience. One of ordinary skill in the art would have found it obvious to automate, via the database, the above-referenced correlating process performed by the user in order to gain the commonly understood benefits of such adaptation, such as saving the user the time spent creating the weightings in the Buyer Profile. *See Leapfrog Enterprises, Inc. v. Fisher-Price, Inc.*, 485 F.3d at 1162. Accordingly, Salmon does render obvious accessing a database that automatically correlates, for a job function, a first industry with a set of second industries with respect to which the job function capability is potentially transferable, as recited in independent claims 3, 80, and 88.

Insofar as the rationale for the basis of this rejection may differ from that set forth by the Examiner, we denominate our affirmance of the rejection of these claims as a new ground of rejection under 37 C.F.R. § 41.50(b) (2008).

Claims 106-110, 113-117, and 120-124

Appellants are also correct in their argument relating to dependent claims 106-110, 113-117, and 120-124 (App. Br. 14). However, for the same reasons as set forth above with respect to dependent claims 7, 13, 16, 18, 20, 22, 25-27, 31-33, 39, 41, 44, 46, 48, 50, 52, 56-58, 60, and 62, Salmon renders obvious accessing a database that automatically correlates, for a job function, a first industry with a set of second industries with respect to which the job function capability is potentially transferable, as recited in independent claims 3, 80, and 88.

Insofar as the rationale for the basis of this rejection may differ from that set forth by the Examiner, we denominate our affirmance of the rejection of these claims as a new ground of rejection under 37 C.F.R. § 41.50(b) (2008).

CONCLUSION OF LAW

On the record before us, Appellants have shown that the Examiner erred in rejecting claims 3-6, 8-12, 14, 15, 17, 19, 21, 23, 24, 28-30, 34-38, 40, 42, 43, 45, 47, 49, 51, 53-55, 59, 61, 80-102, 104, 105, 111, 112, 118, and 119.

On the record before us, Appellants have not shown that the Examiner erred in rejecting claims 7, 13, 16, 18, 20, 22, 25-27, 31-33, 39, 41, 44, 46, 48, 50, 52, 56-58, 60, 62, 106-110, 113-117, and 120-124.

DECISION

The decision of the Examiner to reject claims 3-6, 8-12, 14, 15, 17, 19, 21, 23, 24, 28-30, 34-38, 40, 42, 43, 45, 47, 49, 51, 53-55, 59, 61, 80-102, 104, 105, 111, 112, 118, and 119 is reversed.

The decision of the Examiner to reject claims 7, 13, 16, 18, 20, 22, 25-27, 31-33, 39, 41, 44, 46, 48, 50, 52, 56-58, 60, 62, 106-110, 113-117, and 120-124 is affirmed.

We use our authority under 37 C.F.R. § 41.50(b) to enter a new rationale for rejecting claim 7, 13, 16, 18, 20, 22, 25-27, 31-33, 39, 41, 44, 46, 48, 50, 52, 56-58, 60, and 62 under 35 U.S.C. § 103(a) as unpatentable over Salmon in view of Joao.

We use our authority under 37 C.F.R. § 41.50(b) to enter a new rationale for rejecting claim 106-110, 113-117, and 120-124 under 35 U.S.C. § 103(a) as unpatentable over Salmon.

37 C.F.R. § 41.50(b) provides that, "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

Regarding the new ground of rejection, Appellants must, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, exercise one of the following options with respect to the new ground of rejection, in order to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . [; or]
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a) (2007).

AFFIRMED-IN-PART, 37 C.F.R. § 41.50(b)

hh

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